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EXAMINER

HUYNH, CONG LAC T 20

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 20

Application Number: 09/342,680
Filing Date: June 29, 1999
Appellant(s): ANDERSON ET AL.

Joyce Tom
For Appellant

MAILED
DEC 16 2002
Technology Center 2100

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/11/02.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 7/29/02 (paper #17) has not been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-7, 8-12, 13-20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

6,035,323	NARAYEN	3-1997
5,805,829	COHEN	9-1998
6,058,428	WANG	2-2000

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 8, 11-13 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Xu (US Pat No. 5,848,420 12/8/98, filed 6/14/96) in view of Narayen et al. (US Pat No. 6,035,323, 3/7/00, filed 10/24/97).

Regarding independent claim 1, Xu discloses:

(a) connection between the digital camera and the computer without the need for loading camera-specific communication software (figure 1; col 3, lines 55-67 to col 4, lines 1-3, connecting the camera to the host computer via serial port or serial port equipped camera; col 4, lines 30-45)

(c) mounting the image capture device as a disk on the host computer without the need for loading camera-specific communication software (abstract; col 2, lines 15-35; col 3, lines 55-65; col 4, lines 32-39, mounting the camera as a disk drive accessible by the computer system by a software program)

It is clear that step (a) establishing communication between the image capture device and the host computer, and step (c) mounting the image capture device as a disk on the host computer are performed without having to load device-specific software onto the host computer, since the connection is made via the serial port and the software

program for said mounting in Xu are not a device-specific software or a camera-specific communication software.

Xu does not disclose generating the image files stored in the digital camera into HTML format and opening these files in the computer system without loading any camera-specific communication software onto the host computer.

Narayan discloses:

(b) automatically generating an Internet page description file in the image capture device that references the images stored therein without the need for loading a camera-specific communication software onto the host computer (figure 1, steps 10, 12; figure 5, steps 225, 229)

(d) opening the Internet description file in a web browser on the host computer (figure 5, step 231, 233, images in HTML format are generated and sent to users for viewing), wherein the image stored in the image capture device are displayed on the host computer through the web browser without the need for loading camera-specific communication software onto the host computer (col 5, lines 50-67; col 6, lines 28-45). It is noted that there is a Web authoring software in Narayan, but that software is not a device-specific software or a camera-specific communication software.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Xu into Narayan to obtain a connection between a PC and a digital camera, an access to the digital camera on the operation system of the computer, and a HTML file containing images from the digital camera ready to use

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for users without having to load a camera-specific communication software onto the host computer.

Claims 8,13 are for the system and the computer-readable medium of method claim 1, and therefore are rejected under the same rationale.

Regarding claims 11-12, it was obvious that the Internet page is a HTML page and images are transferred from a digital camera to the host computer and the Internet as disclosed above.

Claims 2-5, 9-10, 14-18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Xu and Narayan as applied to claim 1 above, and further in view of Cohen et al. (US Pat No. 5,805,829, 9/8/98, filed 10/1/96).

Regarding claim 2, which is dependent on claim 1, Xu and Narayan do not disclose the providing of Java files with the Internet page description files in the image capture device.

Cohen discloses that a web page can include programs of Java files called applets for execution live images of the web page content (col 1, lines 20-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Cohen into Narayan and Xu for providing Java files along with the internet page file for executing images captured from the image capture device connected to the host computer.

Regarding claim 3, which is dependent on claim 2, it was well known that compressing is applied for easy transferring image files, which can be Java files as in Cohen, with a large amount of data. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Cohen to include decompressing since it was well known in the art that a compressed file should be decompressed after being transferred for displaying on the web browser.

Regarding claim 4, which is dependent on claim 3, Narayen discloses the generating the Internet page description when the communication with the host computer is indicated (figures 1, 4, 8).

Regarding claim 5, which is dependent on claim 4, Narayen discloses the storing of the images displayed in the web browser on the host computer by copying the compressed images files from the image capture device directly to the host computer (col 6, lines 31-45).

Claims 9-10, 14-18 are for the system and the computer-readable medium of method claims 2-5 and therefore are rejected under the same rationale.

Claims 6-7, 19-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Xu and Narayen as applied to claim 5 above, and further in view of Wang et al. (US Pat No. 6,058,428, 2/5/00, filed 12/5/97).

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Regarding claim 6, which is dependent on claim 5, Xu and Narayen do not disclose the copying of image files, which is determined not being previously copied, to the host computer.

Wang discloses:

- determining if any of the compressed image files have previously been copied to the host computer (col 5, lines 59-67; col 6, lines 42-50)
- copying only the compressed image files to the host computer that have not been previously copied (col 5, lines 59-67; col 6, lines 42-50)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Wang into Narayen to enhance that feature to Xu and Narayen to avoid the duplicate files when copying.

Regarding claim 7, which is dependent on claim 6, Narayen discloses:

- uploading the image files and the internet page description file to the host computer (figures 4, 5, 9)
- opening the internet page description file in the web browser on the host computer to display the images stored in the host computer (figures 4, 5, 9)

Though Narayen does not explicitly disclose the computer on which the web page displayed is the host computer. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have recognized that said computer is a host computer as claimed since it is connected to the digital camera and is where to display images from the digital camera.

Claims 19-20 are for the computer-readable medium of method claims 6-7, and therefore are rejected under the same rationale.

(11) Response to Argument

- Appellants argue that Xu and Narayen fail to teach or suggest mounting the image capture device as a disk on the host computer without the need for loading communication software onto the host computer (appeal brief, page 7). Appellants further emphasize that each step in claim 1 from (a) to (d), including the mounting step, must be performed without having to load device-specific software onto the host computer (appeal brief, page 9) as disclosed in the specification of the invention.

Examiner respectfully disagrees.

It appears that Appellants meant Xu and Narayen fail to teach steps (a) to (d) without having to load device-specific software onto the host computer. Therefore, Appellants' arguments seem to be contradicted since the device-specific software is different from the communication software.

Xu discloses mounting the image capture device as a disk on the host computer without having to load device-specific software onto the host computer. Specifically, Xu discloses the serial port, the serial port equipped camera for connecting the camera to the host computer for permitting the stored images to be directly accessed by the computer system (col 3, lines 55 to col 4, lines 1-3). Xu also discloses a software program for mounting the camera as a disk drive in the host computer (col 4, lines 32-39). It is clear that step (a) establishing communication between the image capture

device and the host computer, **and step (c)** mounting the image capture device as a disk on the host computer **are performed** without having to load device-specific software onto the host computer, **since the connection is made via the serial port and the software program for said mounting in Xu are not a device-specific software or a camera-specific communication software.**

Narayan discloses step (b) generating an Internet page description file in the image capture device that references the images stored therein (figure 1, steps 10, 12; figure 5, steps 225, 229), and step (d) opening the Internet description file in a web browser on the host computer (figure 5, steps 231, 233) wherein the images stored in the image capture device are displayed on the host computer without the need for loading camera-specific communication software onto the host computer (col 5, lines 50-67; col 6, lines 28-45). It is noted that there is a Web authoring software in Narayan, but **that software is not a device-specific software or a camera-specific communication software.** In short, Xu and Narayan disclose four steps (a) to (d) without having to load a camera-specific communication software onto the host computer.

- Appellants argue that Xu in view of Narayan fails to teach or suggest automatically generating an Internet description file or HTML file in an image capture device or a digital camera that references the images stored therein. Appellants point out that the system claim 8 states that "the digital camera including means for generating an Internet page description file..." That means said generating happens

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within the camera whereas generating a description file in Narayan happens in the computer.

Examiner respectfully disagrees.

The invention as a whole is not consistent. In claims 1 and 13, the step generating can happen somewhere, not within the digital camera, whereas in claim 8 said generating does.

Specifically, claim 1 states that “automatically generating an Internet page description file in the image capture device that references the images stored therein.”

Claim 13 states that “automatically generating an HTML file that references the images stored in the digital camera.”

It is clear that said generating an HTML file that, as claimed, references the images stored in the digital camera, and the *Internet page description file* in the image capture device *references the image stored in the image capture device*. It does not state that said generating should happen in the digital camera. Therefore, said generating can happen in a computer system.

Since Narayan discloses automatically generating an Internet page description file that references the images stored in the digital camera where said generating happens in the computer system (figure 1) and in the server computer system (figure 5) as admitted by Appellants (appeal brief, page 12), Narayan, in combination with Xu, disclose the recited limitations in claims 1 and 13.

- Appellants argue that regarding claims 2-5, 9-10, and 14-18, which are dependent on claims 1, 8, and 13 respectively, since Cohen does not mention or suggest mounting an image capture device as a disk on a host computer without the need for loading communication software onto the host computer, or generating an Internet page description file or HTML file in the image capture device or digital camera that references the images stored therein, as recited in independent claims 1, 8, and 13, claims 2-5, 9-10, 14-18 are allowable over Xu in view of Narayen and further in view of Cohen.

Examiner respectfully disagrees.

Though Cohen does not disclose the argued limitations but Xu and Narayen, in combination with Cohen, disclose said limitations as argued above and as in the Grounds of Rejection above.

Therefore, claims 2-5, 9-10, 14-18 remain rejected under 35 U.S.C. 103 (a) as being unpatentable over Xu in view of Narayen and further in view of Cohen.

- Appellants argue that regarding claims 6-7, and 19-20, which are dependent on claims 1 and 13 respectively, like Cohen, since Wang does not mention or suggest mounting an image capture device as a disk on a host computer without the need for loading communication software onto the host computer, or generating an Internet page description file or HTML file in the image capture device or digital camera that references the images stored therein, as recited in independent claims 1 and 13, claims 6-7, 19-20 are allowable over Xu in view of Narayen and further in view of Wang.

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Examiner respectfully disagrees.

Like Cohen, though Wang does not disclose the argued limitations but Xu and Narayen, in combination with Wang, disclose said limitations as argued above and as in the Grounds of Rejection above.

Claims 6-7, 19-20, therefore, remain rejected under 35 U.S.C. as being unpatentable over Xu in view of Narayen and further in view of Wang.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Cong-Lac Huynh
Examiner
Art Unit 2178

clh
December 9, 2002

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